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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,068

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EXAMINER

SCHMIDT, KARL L

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/556,068	<b>Applicant(s)</b> TAGUCHI ET AL.	
	<b>Examiner</b> KARI L. SCHMIDT	<b>Art Unit</b> 2439	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/8/2008, 06/03/2009</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 45-47 are rejected under 35 U.S.C. 101 as falling within one of the four statutory categories of invention. The examiner notes claims 45-47 include programs and functions and therefore constitute software, which is non-statutory subject matter. **See MPEP § 2106 IV.B.I(a).** A computer program listing on a sheet of paper is not considered to provide functionality, and is therefore considered to be **merely a computer program per se**, which is non-statutory subject matter. The examiner notes functional descriptive material, such as a computer program per se, is statutory when it is **stored on a tangible computer readable medium**.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25-47

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 25 and 26 and (similarly: 28)

The examiner notes the phrase "to control transfer of information...", "the information", "before the information including the delivery data stored in the other information processing terminal is re-stored in the information processing terminal" is confusing? What information is being controlled? Is it the digital information or distribution control information? The examiner will interpret it to be any information

Claims 28-33, 37-39, 42-47

The term "safing" is a relative term which renders the claim indefinite. The term "safing" is not defined by the claim, the specification does not provide a standard for

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ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The examiner will interpret “safing” to be a form of a license.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Peinado (US 7,073,063 B2).

#### **Claim 25, 26, 28, 38-39, 42-47**

Peinado discloses a digital information distribution control method in a system having a server for performing a delivery service of digital information and an information processing terminal for receiving the delivery service of the digital information (see at least, FIG 1 and col. 9, lines 1-30: the examiner notes the content server distributes digital content and col. 11, lines 4-14), wherein delivery data including the digital information and distribution control information representing a data transfer control condition is delivered from the server to the information processing terminal (see at

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least, FIG 1 and col. 9, lines 1-30: the examiner notes the content server distributes digital content and col. 11, lines 4-14), the delivery data is stored in the information processing terminal, a first sating data including the delivery data is generated by using terminal unique information allocated to the information processing terminal and transferred to another information processing terminal (see at least, col. 38, lines 1-65: the examiner notes the license is the unique sating data which is generated for the computer), before delivery data included in sating data stored in the other information processing terminal is re-stored in the information processing terminal, a sating data transmission request is transmitted to the other information processing terminal (see at least, col. 37, lines 47-49: the examiner notes the coupling of the portable device to the computer), based on the terminal unique information of the information processing terminal, and terminal unique information and distribution control information included in second sating data corresponding to the sating data transmission request (see at least, col. 38, lines 1-65: the examiner notes the creation of the sub license), it is determined whether the delivery data included in the second sating data can be re-stored in the information processing terminal or not, and the delivery data included in the second sating data is stored in the information processing terminal when the delivery data can be re-stored (see at least, col. 38, lines 1-65: the examiner notes if the license allows or prohibits sub-licensing).

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Claim 27, 29, and 40

Peinado discloses the distribution control information designates at least one of a transfer possibility/impossibility determination condition of the sating information and an inquiry possibility/impossibility determination condition at the server (see at least, col. 38, lines 1-30: the examiner notes a license has can allow or prohibit a sub-license and further the licensor (e.g. license sever) can set the terms (e.g. allow, rules, etc)).

Claim 30 and 41

Peinado discloses wherein when server inquiry is designated by the distribution control information of the second sating data, sating data inquiry including the second sating data and the sating data transmission request is transmitted to the server (see at least, col. 38, lines 1-65: the examiner notes a portable device requesting a sub-license).

Claim 31

Peinado discloses wherein the server determines whether updating of the second sating data included in the sating data inquiry is possible or impossible when the sating data inquiry is received, when the updating is possible, updated sating data obtained by updating the second sating data by using server unique information allocated to the server is generated, and the updated sating data is returned as a response to the sating data inquiry, and the information terminal receives the updated sating data as second sating data corresponding to the sating data transmission request (see at least, col. 38,

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lines 1-30: the examiner notes a license has can allow or prohibit a sub-license and further the licensor (e.g. license sever) can set the terms (e.g. allow, rules, etc)).

### Claim 32

Peinado discloses wherein the updated sating data includes expiration-date information, the information processing terminal, based on the terminal unique information of the information processing terminal, the terminal unique information, expiration-date information, and distribution control information included in the second sating data, determines whether the delivery data can be re-stored in the information processing terminal or not (see at least, col. 31, lines 45-50: the examiner notes validity is a form of expiration and col. 38, lines 1-65)

### Claim 33

Peinado discloses wherein the information processing terminal further adds the request specifying information to the sating data transmission request to transmit the sating data transmission request and the request specifying information to the other information processing terminal (see at least, col. 38, lines 1-65); the server returns the updated sating data including the request specifying information, and the information processing terminal, based on the terminal unique information of the information processing terminal, the terminal unique information, request specifying information, and distribution control information included in the second sating data, determines whether



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the delivery data can be re-stored in the information processing terminal or not (see at least, col. 38, lines 1-65).

Claim 34

Peinado disclose wherein the request specifying information is a random number generated in the data transmission request (see at least. col. 41, lines 25-40: the examiner notes a nonce is a number used only one time (e.g. random)).

Claim 35

Peinado discloses wherein the distribution control information designates at least one of a possibility/impossibility condition of data transfer, a necessity/unnecessity condition of encryption in information transfer, and an inquiry possibility/impossibility condition at the server (see at least, col. 38, lines 1-65).

Claim 36

Peinado discloses wherein the terminal unique information includes at least the identification information of a distribution signature creating key, a distribution signature verifying key, a terminal certification, an encrypting key, an encrypting key certification, a decrypting key, and identification information (see at least, col. 38, lines 1-65).

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Claim 37

Peinado discloses wherein the information processing terminal encrypts digital information included in the delivery data by using the encrypting key included in the terminal unique information when the distribution control information designates encryption in data transfer, generates the first sating data by using the delivery data including the encrypted digital information to transfer the first sating data to the other information processing terminal, and decrypts the encrypted digital information of the delivery data included in the second sating data by using the decrypting key included in the terminal unique information (see at least, col. 38, lines 1-65).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 attached.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARI L. SCHMIDT whose telephone number is (571) 270-1385. The examiner can normally be reached on Monday - Friday: 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on 571-272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kari L Schmidt/  
Examiner, Art Unit 2439

/Michael J Simitoski/  
Primary Examiner, Art Unit 2439